



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,486	02/24/2004	Robert Levin	SES 2539.1.1	6761
2147	7590	07/06/2011		
GRACE J FISHEL			EXAMINER	
2200 WEST PORT PLAZA DRIVE			COLLINS, DOLORES R	
SUITE 202				
ST. LOUIS, MO 63146			ART UNIT	PAPER NUMBER
			3711	
			MAIL DATE	DELIVERY MODE
			07/06/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,486

Applicant(s)

LEVIN, ROBERT

Examiner

DOLORES COLLINS

Art Unit

3711

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/2/11.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's response of 5/2/11 is herein noted. The cancellation of claim 3 is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based upon consideration of all the relevant factors with respect to the claims as a whole, Claim(s) 1 is held to claim an abstract idea, and is rejected as ineligible subject matter under 35 U.S.C. 101.

The rationale for this finding is explained below, which is a result of careful consideration of the listed factors when analyzing the claims as a whole to evaluate whether a method claim is directed to an abstract idea. These factors are not intended to be exclusive or exhaustive.

I. Factors weighing toward eligibility are:

a) Recitation of a machine or transformation: In particular, machine or transformation meaningfully limits the execution of the steps, a machine implements the claimed steps, the article being transformed is particular, an object or substance, the article undergoes a change in state or thing (objectively different function or use);

b) Practically applying a law of nature to meaningfully limit the execution of the steps; or

c) The claim is more than a mere statement of a concept: It describes a particular solution of the problem to be solved; implements a concept in a tangible way, performance of steps are observable and verifiable.

II. Factors weighing against eligibility are:

a) No recitation or insufficient recitation of a machine or transformation:

+ Insufficient involvement of the machine or transformation, merely nominally, insignificantly, or intangibly related to the performance of the steps, (e.g., data gathering, or merely recites a field in which the method is intended to be applied).

+ Machine is generically recited such that it covers any machine capable of performing the claimed step(s) or merely an object on which the method operates.

+ Transformation involves only a change in position or location of the article.

b) Improperly applying a law of nature that would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature); or applied in a merely subjective determination or merely nominally, insignificantly, or tangentially related to the performance of the steps; or

c) The claim is a mere statement of a general concept: Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept; or both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus; or states only a problem to be solved; or general concept is disembodied; or mechanism by which the step(s) are implemented is subjective or imperceptible.

+ Examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or relationships, teaching concepts, human behavior, and instructing how business should be conducted.

Claim 1 is ineligible subject matter because the claimed limitations include no recitation or insufficient recitation of a machine or transformation, or not directed to a proper application of a law of nature, or just a mere statement of a general concept.

In this case, the fact that no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are indicators that applicant's are attempting to patent an abstract idea. None of the steps are performed by a machine, but rather are performed by a human being.

Response to Arguments

Applicant's arguments filed 5/2/11 have been fully considered but they are not persuasive. Applicant has amended claim 1 and cancelled claim 3 in an effort to overcome the rejection under 35 USC 101. Applicant has further argued case law upon which the rejection under 35 USC 101 relies. In response to Applicant's argument, The Supreme Court did indicate that the machine or transformation test is "not the sole test for patent eligibility", but that it may be a "useful and important clue or investigative tool" for deciding whether an invention is a patent eligible process under 35 USC 101. In this case, the facts that no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are indicators that applicant's are attempting to patent an abstract idea. None of the steps are performed by a machine, but rather are performed by a human being.

Applicant's claimed method, while arguably reciting a number of physical steps, is viewed here as an attempt to claim a new set of rules for playing a game. In this examiner's opinion, a set of rules qualifies as an abstract idea. Therefore, the examiner maintains that Applicant's claimed method, although couched in terms of a few actual physical steps, is a clear attempt to claim an abstract idea in the form of a new set of rules for playing a card game. Since the claimed method requires no machine implementation, requires no transformation of a particular article and is seen as an attempt to receive patent protection for an abstract idea in the form of a new set of rules, the examiner maintains that the claimed method is not patent eligible.

It is noted here that several factors factors weighing toward and against patent eligibility have been analyzed by the examiner, including but not limited to the machine and transformation factors and the abstract idea or general concept factors discussed above. See the Federal Register notice entitled "Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos* (Fed. Reg. Vol. 75, No. 143/Tuesday, July 27, 2010/Notices) for a complete list of factors that were considered by the examiner in the above analysis. Specifically, the lack of implementation by a particular machine or the transformation of a particular article, the lack of a meaningful limit imposed by the device or table and the apparent attempt to claim an abstract idea in the form of a new set of rules are all factors that weigh against eligibility. The fact that the claim may be more than a mere statement of a concept in that an actual method of playing the game is claimed versus just a new set of rules may be a factor weighing towards patent eligibility. However, in this case that factor weighing towards eligibility is not given much weight since the use of the concept, as expressed in the method, would effectively grant a monopoly over the concept. It is this examiner's opinion that the factors in this case weighing against patent eligibility far outweigh the factors weighing toward patent eligibility. The rejection of claim 1 under 35 USC 101 as directed to non-statutory subject matter is maintained for the above reasons.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited to show the state of art with respect to features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DOLORES COLLINS** whose telephone number is **(571)272-4421**. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Eugene Kim** can be reached on **(571) 272-4463**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

/DOLORES COLLINS/
Examiner, Art Unit 3711

/ALVIN A HUNTER/
Primary Examiner, Art Unit 3711